

COMMENTS / ARGUMENTS

§101 Rejections

Claims 1 and 14 have been amended as suggested to overcome the §101 rejections. Removal of the rejections is respectfully requested.

§112 Rejections

Claims 1-4, 9-17, 19-21, and 23-26 are rejected as not being enabled. Applicant notes that the specification states "Third, the respondent or client receives and reads the Hallmark Analysis report and individual assessment Instrument reports, noting observations and questions." paragraph [0038]. One of skill in the art readily understands that for a computing device to process data and then provide a report to an individual such that the individual can read it, make observations, and formulate questions, this process involves printing the report on paper, saving the report to a computer file, or displaying the report on a display screen. Furthermore, the rejection states that printers and/or displays are not explicitly present in the specification. The Official Action admits that certain of these structures may be inherent in the cited computers, indeed they are. Given a computer meeting all of the other limitations of the claim, one of skill in the art would be readily able to have that computer generate a report in printed form, as a computer file, or on a display screen. Also, while the rejection points out believed deficiencies, the rejection fails to state that there is a deficiency in enablement of structure for "saving the report to a computer file." Given that the claim language of "at least one of a printed report, a computer file, or a display screen," the clear support for creating computer files provides support for the entire limitation grouping.

§102 & §103

The claims have also been rejected under §102 & §103 similarly to previous Office Actions. In that the rejections are identical, Applicant reiterates the previous response thereto, embodied at least, in the Appeal Brief of January 27, 2010.

The Examiner has added some new argument in the "Response to Arguments" section. Accordingly, Applicant will provide response to these new arguments as appropriate, below.

The Examiner has noted that a reference is presumed to be enabled and stated that Applicant has failed to analyze the Wood reference in view of the Wands factors. Applicant notes that the Colquitt Declaration of 9/25/09 (attached) specifically discussed many of the Wands factors and found the Wood reference to be completely non-enabling with respect to the present claims. Dr. Colquitt discussed the breadth of the claims and the state of the prior art by noting that the claims are directed towards rating competencies through the use of capability tests and noting that Wood provided no such disclosure. Furthermore, using capability tests to rate competencies is not a predictable art. The ability to take questions from other capability tests that are each a standardized measure of a psychological construct and then being able to use those questions to generate a separate indication of competencies is not a matter of just picking questions and mapping them to a new outcome. There is much experimentation necessary to determine what questions to use and how to use them.

Overall, Applicant submits that Dr. Colquitt's declaration of 9/25/09 explicitly details why one of skill in the art would find the Wood reference non-enabling with respect to the claims at issue. Furthermore, as noted, the Examiner is an electrical engineer by trade and does not have the years of training and experience in the areas of test development, test validation, and psychometrics. A professional having a degree in Electrical Engineering alone would not be one of skill in the art of test development, test validation, and employment personality testing. The Examiner's stated beliefs of the interchangeability of capability testing and competency testing due to his understood meanings of the words and definitions pulled from general sources cannot be held to trump the knowledge of Dr. Colquitt. Dr. Colquitt has examined the cited references, reviewed the standing rejections, and declared that there are many details missing therefrom that would prevent one of skill in the art from arriving at the claimed invention.

The Examiner's comments further state that the meaning of the terms of "competency, capability, and cross-referencing" have not been sufficiently developed in the claim language. Again, applicant notes that this perceived lack of development is due to the Examiner not being

Appl. No. 10/823,829

of the level of skill in the art. Dr. Colquitt is of skill in the art, readily understands these terms, and notes that they provide a meaningful difference between the claims and the cited art. There is no justification for ignoring the statements of one of skill in the art and substituting the Examiner's judgment over the judgment of one of skill in the art.

The application is believed to be again ready for appeal.

Conclusion

Should any questions concerning any of the foregoing arise, Examiner is invited to telephone the undersigned at (317) 237-0300.

In the event that Applicants have overlooked the need for an extension of time or a payment of fee, Applicants hereby conditionally petition therefore and authorize that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

Respectfully submitted,

/Ryan C. Barker/
Ryan C. Barker, Reg. No. 47,405
Attorney for Applicants
BAKER & DANIELS
300 North Meridian Street
Suite 2700
Indianapolis, IN 46204
Telephone: (317) 237-0300
Fax: (317) 237-1000

Date Submitted: October 26, 2010